

cc

Subject

ep 998539B; our VK 0001EO;

Your:

692. 87078/01

Jamie:

this is a follow up to our conversation on the above topic. This really relates to enforcement of some of the Aux Claims proposed. See 2d and 3d Auxiliary Requests.

In particular, with respect to the claim 1 of each of the 2d & 3d Aux. Req. at element (i), the language of either "in an amount of 30-50%" or "in an amount of 50%" if I were to try to enforce such a claim on a component having element (i) at 51% or 49% (the ASRHAE tolerance on this component for the composition known as R417A is 50% +/- 1% -- would I be able to argue literal infringement in the UK, Germany and France? [assume all of the other components present in the accused composition and well within the component ranges as set forth in the claims as now drafted.]

If not literal, is there any legal concept by which I could assert infringement of these Claim 1s?

If you would like to discuss, please give me a call in the morning or next week,

thanks in advance,
best,
mary ann

Mary Ann Capria
Corporate Counsel
DuPont Legal
302-992-3749

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**Translation of a Letter from Solvay to the EPO
dated 30 March 2006**

**Our reference: OPP S 365
Appeal Procedure T 894/05-3.3.10**

The Opponent hereby submits observations relating to the Appeal Statement submitted by the Patentee and passed on to us on 20.09.2005.

1. NEW REQUESTS BY THE PATENTEE

The Opponents are of the opinion that none of the new requests meets the requirements of the EPC. They therefore maintain their request for total revocation of the contested patent.

With regard to the request by the Patentee to refer the case in the first instance for a decision as to the priority rights, the Opponents submit that this question falls within the scope of assessing the novelty of the object of the contested patent in the light of Citation D1. In fact, the Opposition Division has indisputably made a decision on this question.

The Opponents now submit that the two parties are benefiting in the present instance from the twofold jurisdiction as regards this question which was settled by the Opposition Division.

2. GROUNDS APPLYING EQUALLY TO ALL THE REQUESTS

2.1 NOVELTY IN RELATION TO D1

To avoid rerequest, the Opponents refer to section 2.1-2.3 of their Appeal Statement. The arguments demonstrating lack of novelty also apply to the new requests.

In fact, the independent claims of all the new requests include the feature "... hydrocarbon ... in an amount from 1 to 4% by weight" which is not disclosed in the Priority Document. Thus, each set of claims includes a dependent claim containing a range created starting from the point

HFC-125/HFC-134a/R-600 46.5/50/3.5, a point which is absent from the Priority Document.

At least all the above mentioned claims are anticipated by the disclosure in D1 of a composition HFC-125/HFC-134a/R-600 46.5/50/3.5 used as a coolant as a replacement for R-22.

2.2 NOVELTY IN RELATION TO D2

The independent claims of all the requests include the composition which is the object of the request upheld by the Opposition Division. The Opponent therefore considers these requests to be anticipated by D2 for the reasons stated in section 2.4 of their Appeal Statement.

2.3 INVENTIVE STEP

In the absence of a request which meets the novelty requirements, the Opponents refer here to section 3 of their Appeal Statement and section 5 of their Opposition Statement and the documents cited in these submissions.

2.4 ARTICLE 123(2)

In spite of the cancellation of claim 16 from the patent as granted, corresponding to claim 15 of the first auxiliary request considered by the Opposition Division, the dependent claims 14 and 17 of the main request and corresponding claims in the auxiliary requests are not allowable for the reasons described, *inter alia*, in section 5.5 of the Decision by the Opposition Division.

3. SPECIFIC OBJECTIONS TO THE DIFFERENT REQUESTS

3.1 MAIN REQUEST

3.1.1 Article 83

The Opponent wishes to draw the attention of the Appeals Board to the Appeal Statement submitted by the Patentee, namely page 4, which makes the following statement regarding the teaching of the contested patent:

"Furthermore, there is no disclosure anywhere in the application as filed that the refrigerant composition may comprise additional components or what these components may be".

This confirms that the objection of insufficient disclosure initially raised by the Opponent (in section 2 of the Opposition Statement) is well founded. The Patentees themselves are in fact confirming that the contested patent does not contain any information which would allow the skilled man to use compositions according to claim 1 of the Main Request, containing 30% of component (i).

3.1.2 Article 123(2)

It is well established that when features are combined in a document it is this combination which must unequivocally derive from the document.

On this subject the Opponents quote once again from the Appeal Statement submitted by the Patentee, page 3:

"It is pointed out that each of the broadest, and preferred ranges relied upon for the amendments in the present Main Request are disclosed in the application in a general sense, in separate paragraphs (page 3, lines 10-13 and line 36 to page 4, line 1). They are neither associated with particular compounds specified for each component nor associated with particular ranges for the other components forming the refrigerant composition. Consequently, these disclosures represent generic ranges for each component which can therefore be combined without the introduction of a new technical teaching which was not present in the application as filed."

The Opponents agree with the analysis of the Patentee according to which the ranges disclosed are of a generic nature and there is nothing in the application as filed to support more specific combinations which associate these ranges with specific compounds or particular ranges.

In fact, the conclusion drawn, implying that for any specific constituent every combination of specific concentration ranges would be disclosed, contradicts the basic principle accepted by the EPO, according to which the generic does not disclose the specific contained within the generic or, even more so, a combination of several specific individual cases.

The interpretation of the application as filed, as given by the Patentees themselves, thus confirms that the decision taken by the Opposition Division as described in section 5.3 is well founded and supports the arguments put forward by the Opponents in section 1 of their Opposition Statement confirming that the claims corresponding to the Main Request infringe Article 123(2) EPC.

3.2 FIRST AND SECOND AUXILIARY REQUESTS

The Opponent is of the opinion that the objections under Article 83 and 123(2) explained in section 3.1 apply equally to the first and second Auxiliary Requests.

3.3 THIRD AUXILIARY REQUEST

The Opponents refer to their Appeal Statement which related in particular to this request corresponding substantially to the request upheld by the Opposition Division. They also repeat that the cancellation of claim 7 of the request upheld by the Opposition Division does not overcome the fact that dependent claims 6 and 9 do not meet the requirements of Article 123(2) EPC for the reasons set out in sections 1.6 and 1.7 of the Appeal Statement.

CONCLUSION

The Opponent/Petitioner is of the opinion that none of the present requests meets the requirements of the EPC. They are therefore of the opinion that their request for revocation of the contested patent is entirely justified and they confirm that they will be seeking oral proceedings prior to any decision which does not revoke the contested patent.

Signed, the Agent

Stefan MROSS



"Jamie Thomson"
<Jamiet@frankbdehn.com>
05/18/2006 09:00 AM

To Mary Ann Capria/AE/DuPont@DuPont
cc
bcc
Subject RE: Translation of Solvay papers? ep 998539B; our VK
0001EO;Your: 692. 87078/01

Dear Mary Ann

Further to your e-mail appended below, I attach a copy of the English translation of the Solvay's further submissions.

Kind regards,

Jamie

-----Original Message-----

From: Mary Ann Capria [mailto:Mary-Ann.Capria@usa.dupont.com]
Sent: 15 May 2006 18:34
To: Jamie Thomson
Subject: Translation of Solvay papers? ep 998539B; our VK 0001EO;Your:
692. 87078/01

Jamie:

Just checking to see if you have received the translation of the latest Solvay document filed in the EPO relating to the above referenced EU Opposition.

I need to review this document as soon as possible as it could related to other matters in the family of the above referenced patent.
Thanks much for your kind attention to the various pending matters with this Opposition.

best,
mary ann

Mary Ann Capria
Corporate Counsel
DuPont Legal
302-992-3749

----- Forwarded by Mary Ann Capria/AE/DuPont on 05/15/2006 01:33 PM

Mary Ann
Capria/AE/DuPont

To
05/11/2006 07:10 PM
jamiet@frankbdehn.co.uk